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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,574	11/03/2000	Vernon M. Ingram	M0656/7060	6165

7590 05/01/2003

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EXAMINER
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CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 05/01/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

# Office Action Summary

Application No.  
09/706,574

Applicant(s)  
Ingram et al.

Examiner  
Bennett Celsa

Art Unit  
1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9 and 29-49 is/are pending in the application.
- 4a) Of the above, claim(s) 9 and 29-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40, 41, 43-46, 48, and 49 is/are allowed.
- 6) ☒ Claim(s) 42 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Status of the Claims***

Claims 9 and 29-49 are currently pending.

Claims 9 and 29-39 are withdrawn from consideration as being directed to a nonelected invention.

Claims 40-49 are under consideration.

**NOTE:** the location of the present application is ART UNIT 1639.

### ***Election/Restriction***

1. Applicant's election without traverse of Group IV (claims 40-49) in Paper No.13 is acknowledged.
2. Applicant's election with traverse of CNQX (e.g. candidate small molecule) in Paper No.IV which reads on claims 40, 42-45 and 47-49 is acknowledged. The traversal is on the ground(s) that "the species will not result in the exertion of additional searching and examination ... [T]he nature of the pharmacological agent ... is unimportant to the patentability of the independent method claims ..." . Upon further search and consideration, the election of species is hereby withdrawn.

The requirement, as modified, is still deemed proper and is therefore made FINAL.

3. Claims 9 and 29-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected , there being no allowable generic or linking claim.

Election was made without traverse in Paper No. .

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***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

***Specification***

***Information Disclosure Statement***

5. The disclosure is objected to because of the following informalities: The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the Examiner on form PTO-892, they have not been considered.

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***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 42 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "small organic molecule" in claims 42 and 47 is a relative term which renders the claim indefinite. The term "small organic molecule" is not defined by the claim, nor does the specification provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

8. ***Cited Document of Interest:***

- a. PG Pub. US 2002/0004194 A1 (Lee et al.)
- b. WO98/30229A1.
- c. US Pat. No. 5,876,948.

***Allowable Subject Matter***

9. Claims 40-41, 43-46, 48 and 49 are allowable over the prior art of record..

10. Claims 42 and 47 would be allowable if amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, neither discloses nor suggests the presently claimed assay of identifying lead compounds by screening for disruption of Abeta aggregation by using a method employing the

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present claimed method steps e.g. a detectable "potentiometric compound" which influxes into the neural cell upon depolarization caused by beta amyloid peptide aggregation and provides detection.

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)  
April 28, 2003

BENNETT CELSA  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bennett Celsa', written over a horizontal line.